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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,416	02/14/2006	Seiichi Murakami	060118	7562
23850 7590 06/22/2011 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. 4th Floor WASHINGTON, DC 20005				
EXAMINER				
JOSEPH, DENNIS P				
ART UNIT		PAPER NUMBER		
2629				
MAIL DATE		DELIVERY MODE		
06/22/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,416

Applicant(s)

MURAKAMI, SEIICHI

Examiner

DENNIS JOSEPH

Art Unit

2629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to arguments filed for No. 10/568,416 on May 25, 2011. Claims 1-6 and 8-11 are pending and have been examined.

Continued Examination

2. In view of the appeal brief filed on May 25, 2011, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-6 and 8-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yukio (JP 2002-259054) in view of Bachus (5,760,862). Please note the Yukio reference is an art described in the background of the present invention and is described in Figure 7.

Yukio teaches in Claim 1:

A transparent touch panel comprising:

a transparent first substrate (**Drawing 2, substrate 130, [0017] discloses a glass material**) and a second substrate (**Drawing 2, substrate 110**) each having a transparent electro-conductive layer on one surface thereof (**Drawing 2, [0016]-[0017] shows electro-conductive layers 111 and 131**), the transparent first substrate and the second substrate being arranged with a predetermined interval between each other in such a manner that the transparent electro-conductive layers are facing each other (**Drawing 2 shows the interval between them. Also please note spacers 160**), each transparent electro-conductive layer including a respective pair of electrodes disposed on each end (**Drawing 2, [0016]-[0019], please note electrodes 112**

(on each end) for the substrate 110 and electrodes 132 (on each end) for the substrate 130 as well)

a plurality of lead-out terminals being connected to the electrodes through surrounding circuits extending to the peripheral edges of the first substrate and the second substrate, the lead-out terminals each being arranged on the opposing surfaces of the first substrate and the second substrate (**Drawing 2, [0016]-[0019], shows peripheral terminals 114 (read as lead-out terminals) on the substrate 110 and terminals 134 on the substrate 130. Also please note the wiring connecting them to the terminals, notably circuit pattern 113 (read as surrounding circuits). Drawing 2 further shows that the terminals are arranged on opposing surfaces facing each other, so that they can be bonded together)**; but

Yukio does not explicitly teach of “a plurality of holding members that pinch a peripheral edge of only the transparent first substrate so as to sandwich a periphery of the transparent first substrate, the holding member being formed of an electro-conductive material and arranged so that each holding member includes a portion inserted between the transparent first substrate and the second substrate and in contact with at least one respective lead-out terminal of either the first or second substrate.”

However, in the same field of endeavor, substrate structure, Bachus teaches of using a plurality of U-shaped conductor parts 12 which is electrically conducting, (Bachus, Figure 2, Column 3, Lines 5-10) that sandwich an edge portion of transparent substrate 3 (Bachus, Column 2, Lines 46-51). Please note Figure 2 which shows the conductor parts 12 is inserted between the

substrate 3 and other substrate 4. From Figures 2 and 3, the conductor parts are electrically coupled to the zebra contacts 14 and are akin to the terminals of Yukio. As combined with Yukio, the conductor parts of Bachus can be used to sandwich just one of Yukio's substrates, such as pinching the glass substrate, and to be connected with the terminals of Yukio. Several KSR principles can be applied here, such as well known technique (clips/clamps on the ends of substrates are well known to pinch the substrate leading to a more compact structure), simple substitution of parts (given the button can be easily implemented in Yukio along the periphery to connect the substrate to the terminals) and obvious to try (given that with the well known benefits and need for a more compact structure, one of ordinary skill would realize to pinch the substrate or minimize their space).

Therefore, it would be obvious to one of ordinary skill in the art, at the time of the invention, to implement the plurality of conductor parts, as taught by Bachus, with Yukio's substrate device, with the motivation of the KSR principles above and that by pinching/sandwiching the substrate, the gap can be abbreviated, leading to a flatter, smaller device, (Bachus, Column 2, Lines 6-12).

Yukio and Bachus teach in Claim 2:

The transparent touch panel according to claim 1, wherein the thickness of the portions of the holding members inserted between the transparent first substrate and the second substrate is 0.5 to 2 times the space between the transparent first substrate and the second substrate. (**Respectfully, this is an optimization issue and according to KSR principles and case law, a design choice to obtain a smaller device. One of ordinary skill in the art would realize to**

design the thickness so that the buttons would be sufficient to fit around the substrate and to provide an adequate space between the two substrates. Please note that Yukio also has spacers to provide distancing between the two substrates, so it is an issue that is relevant to his invention as well that he seeks to address. Please note the combination to teach of the conductor parts, as taught by Bachus, for the same reasoning, to vary the thickness)

Yukio and Bachus teach in Claim 3:

The transparent touch panel according to claim 1, comprising notched portions formed in a portion of the second substrate which is in contact with the holding members. (**Yukio, Drawing 2, [0018] shows insert part 142, formed in the second substrate. Please note the combination with Bachus to place conductor parts in this region, with regards to the terminals 114 and 134)**

Yukio and Bachus teach in Claim 4:

The transparent touch panel according to claim 1, wherein the transparent first substrate has a plurality of groove portions in the surface opposite to the surface on which the transparent electro-conductive layer is formed, and the holding members are held in groove portions. (As combined with Bachus, please note the grooves 17 for the conductor parts to be placed on, **Column 4, Lines 25-32 Respectfully, 3D molded substrates are well known in the art which can deform parts of the substrate and the combination of the two references teaches to use the buttons to firmly press the substrate(s), so having a molded substrate in which the buttons could form into would be obvious to one of ordinary skill in the art to allow for the**

buttons to further press down and with the motivation that the buttons would not come out easily and possibly damage the device entirely. Please note KSR principles such as known technique (substrates with recesses), obvious to try to yield predictable results (obvious to have to provide firm connection for the buttons since finding a secure connection is an issue in the art for these buttons) and simple substitution (having a molded substrate would not destroy Yukio).)

Yukio teaches in Claim 5:

The transparent touch panel according to claim 1, wherein the transparent first substrate is a fixed substrate. (**[0002] of the present invention, which discloses the Yukio invention, notes that 130 is a fixed substrate. Also please note [0017] of Yukio)**

Yukio and Bachus teach in Claim 6:

An electronic apparatus comprising the transparent touch panel of claim 1 and a display apparatus including electrically-conductive connecting terminals, the transparent touch panel being disposed on a display surface side of the display apparatus, and the holding members being in direct contact with the connecting terminals, whereby the apparatus and the lead-out terminals are electrically coupled. (**Respectfully, it is obvious the transparent side is disposed on the display surface side of the touch panel, Drawing 2 of Yukio shows the terminals being electrically coupled by the circuit pattern 133 for receiving and sending display signals from the appropriate drivers and the combination with Bachus teaches to use the conductor parts with the terminals)**

Bachus teaches in Claim 8:

The transparent touch panel according to claim 1, wherein the holding member are U-shaped and an interior of the U overlaps the at least one peripheral edge of the transparent first substrate. (**Bachus, Figure 2 Column 1, Lines 47-55, shows an U-shaped structure and the interior part covers the glass substrate 3**)

Yukio and Bachus teach in Claim 9:

The electronic apparatus according to claim 6, wherein the holding members are U-shaped, an interior of the U overlaps the at least one peripheral edge of the transparent first substrate (**Bachus, Figure 2 Column 1, Lines 47-55, shows an U-shaped structure and the interior part covers the glass substrate 3**), and the connecting terminals are in direct contact with a leg of the U-shape. (**The combination with Yukio teaches to place the holding members over the terminals 114/134**)

Bachus teaches in Claim 10:

The transparent touch panel according to claim 1, wherein the peripheral edge of the transparent first substrate is sandwiched between an upper-side surface and a lower-side surface of each holding member. (**Bachus, Figure 2 shows the first substrate 3 is sandwiched between the upper and lower sides of the conductor parts 12**)

Yukio and Bachus teach in Claim 11:

The transparent touch panel according to claim 3, wherein a warp of the notched portions generates pressing force between the movable substrate and the holding members. (

Respectfully, the combination teaches to place the conductor parts over the terminals through the notched portions, please see Drawing 2 of Yukio and the 103 combination above. The conductor parts are designed to press the substrates from both ends, obviously creating a pressing force, please see the sandwiching descriptions as noted by Bachus)

Response to Arguments

6. Applicant's arguments with respect to claim 1-6 and 8-11 have been considered and are persuasive. As a result, the previous rejection has been removed and a new one has been given in its place.

Given the arguments were directed at the teaching of the secondary reference, Mikio, which is no longer being applied, Applicant's arguments are moot.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS P. JOSEPH whose telephone number is (571)270-1459. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on 571-272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJ

/Amr Awad/
Supervisory Patent Examiner, Art Unit 2629